



REMARKS

In the Advisory Action dated September 10, 2003, claims 1-17 were presented for examination. Claims 1, 3-6, and 12-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Zhang et al.*, U.S. Patent No. 6,119,160 in view of *Kilkki et al.*, U.S. Patent No. 6,230,144. Claims 2, 7-11, and 6-7 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Zhang et al.*

Applicants wish to thank the Examiner for the careful and thorough review and action on the merits in this application.

I. 35 U.S.C. §103(a) - Obviousness in view of *Zhang et al.* and *Kilkki et al.*

Claims 1, 3-6, and 12-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Zhang et al.*, U.S. Patent No. 6,119,160, in view of *Kilkki et al.*, U.S. Patent No. 6,230,144. More specifically, the Examiner stated that the basis for the combination of *Zhang et al.* with *Kilkki et al.* must not emanate from the references themselves. The Examiner further stated that they are considered a person of ordinary skill in the art. See Advisory Action Continuation Sheet, second paragraph. Although the language of the Examiner is not precise, it appears that the Examiner agrees with Applicant that the motivation for the combination of the references is not found within the references themselves as the Examiner needed to utilize the knowledge of "a person of ordinary skill in the art" to substantiate the Examiner's rejection. However, in the present case, the only person of ordinary skill in the art cited by the Examiner is the Examiner herself. Accordingly, the Examiner utilizes herself as "a person of ordinary skill in the art" to complete the missing link required to maintain the rejection.

Applicant hereby incorporates the comments pertaining to both *Zhang et al.* and *Kilkki et al.* in the Response to the Second Office Action dated August 18, 2003.

The Examiner properly states that a person of ordinary skill in the art may provide the

motivation for combining references to construct the Applicant's claimed invention. As the Examiner states in the second paragraph of the Advisory Action: "In addition of being specifically taught in a reference, a person of ordinary skill in the art can also provide such motivational statement." Advisory Action, Continuation sheet, second paragraph. However, a motivational statement absent evidence to support such statement is not permissible in establishing a prima facie case of obviousness. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). In the absence of evidence supporting the Examiner's statement, the statement is merely that - a statement of what the Examiner believes to be the facts without actual presentation of facts in substantiation of the Examiner's claim. However, it is well accepted and recognized that the U.S. Patent and Trademark Office has the burden of establishing a prima facie case of obviousness, without the use of hindsight reconstruction. "It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Accordingly, the Examiner must substantiate their statement that one of ordinary skill in the art would lead that individual to combine the relevant teachings of the cited references.

Additionally, the Examiner's statement that they, as one of ordinary skill in the art, would have been motivated to combine the cited references to create the Applicant's claimed invention creates a much deeper and troubling problem. In the Second Office Action, as well as the Advisory Action, the Examiner merely creates the suggestion by a statement that they can effectively act as the person of ordinary skill in the art without providing any objective evidence to support the conclusions they reach. A mere statement to that effect by an Examiner who has first hand knowledge of the Applicant's claimed invention would have the result that no objective evidence need ever be presented for an obviousness rejection to be asserted and would

allow for the very hindsight reconstruction expressly prohibited by the Court.¹ This result would do away with any further need for evidence, prior art citations or other substantiation, as the mere statement that an Examiner believes that he/she could have constructed an Applicant's claimed invention based on their knowledge would suffice. In fact the Court has already addressed this matter and concluded that "[i]f such rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance." *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). Accordingly, an Examiner must do more than merely state that it is their belief that an Applicant's claimed invention is obvious in order to establish a prima facie case of obviousness.

¹ Please note that the Applicant does not wish to question the Examiner's skill and knowledge with regard to the subject matter of the Applicant's pending application. However, as a practice, to allow the Examiner to act as a person of ordinary skill in the art for purposes of an obviousness rejection without the need to provide any objective evidence in support of the Examiner's conclusion would be the apodeme of hindsight reconstruction. The Examiner is one of the only parties that would have hindsight knowledge of Applicant's invention as the Examiner has access to Applicant's full specification and disclosure in the form of the Applicant's patent application. In order for the Examiner to stand as the person of ordinary skill in the art without their hindsight knowledge, they would need to unlearn all they know from the Applicant's disclosure and specification. Accordingly, absent the unlearning of the knowledge from Applicant's patent application, one would be unable to objectively determine what element of the Examiner's knowledge may have its source in hindsight reconstruction of Applicant's invention.

II. 35 U.S.C. §102(e) - Anticipation by *Zhang et al.*

Claims 2, 7-11, and 16-17 were rejected under 35 U.S.C. §102(e) as being unpatentable over *Zhang et al.*

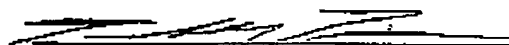
Applicants hereby incorporates the comments pertaining to both *Zhang et al.* and *Kilkki et al.* above.

With respect to this grouping of claims, the Examiner has noted that the Abstract of *Zhang et al.* patent makes reference to "events that need to be accounted". The following sentence outlines these events as "user account logon, the service establishments and the Point to Point protocol (PPP) connections between the gateway device and public and private domains within the network." See Abstract, lines 7-9. Applicants invention does not pertain to the time or time related events outlined by *Zhang et al.* Applicant's pending claims 2 and 7-11, and 16-17 specifically relate to a webserver function and usage calculation. *Zhang et al.* does not relate to accounting for usage based upon the principles claimed by Applicant. Rather, *Zhang et al.* is based upon accounting for connections to a service and duration associated therewith. Applicants invention does not account for event duration of any sort. Rather, Applicants claims pertain to account based upon function accesses, and more specifically, the quantity of instances a webserver function has been accessed rather than the events outlined by *Zhang et al.* "A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986). It is clear in *Zhang et al.* that the multiple level accounting is not the same accounting as taught by Applicant. For example, *Zhang et al.* does not multiply the number of uses of the function accessed by the user by the weight assigned to that function, as specified by Applicant in claims 2 and 7. Accordingly, Applicant respectfully requests the Examiner remove the anticipation rejection, and grant allowance of this grouping of claims.

In light of the foregoing amendments and remarks, all of the claims now presented are in condition for allowancc, and Applicants respectfully request that the outstanding rejections be withdrawn and this application be passed to issue.

The Examiner is urged to call the undersigned at the number listed below if, in the Examiner's opinion, such a phone conference would aid in furthering the prosecution of this application.

Respectfully submitted,



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The transmission ends with this page